

Applicant : J. Robin Tuttle  
 Serial No. : 10/656,485  
 Page : 6

# REMARKS

Applicant acknowledges the Examiner's review of the specification, claims, and drawings. In light of the above amendments and following remarks, Applicant respectfully requests reconsideration of the present application. The amendments and remarks presented herein are fully supported by the application as originally filed. No new matter has been entered.

## STATUS OF THE CLAIMS:

Claims 1-4, 6-8, 10-19, 21, and 24 are pending in the application. Claim 5 was previously cancelled. Claims 9, 20, 22 and 23 are cancelled herein.

## CLAIM REJECTIONS:

The Examiner rejects Claims 1, 9, 16, 18, and 23-24 under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 3,151,649 to Mitchell.

The Examiner rejects Claims 1, 6-9, 13-16, 18, and 23-24 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,622,307 to Wosje.

The Examiner rejects Claims 2-4, 6, 19, and 17 under 35 U.S.C. § 103(a) as being obvious over Mitchell in view of U.S. Patent No. 5,031,808 to Dolenc.

The Examiner rejects Claims 2-4 and 19 under 35 U.S.C. § 103(a) as being obvious over Wosje in view of Dolenc.

The Examiner rejects Claims 11 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Wosje in view U.S. Patent No. 1,606,944 to Johnson.

Applicant respectfully traverses. Applicant's invention is directed to a holder for a vehicle window that is particularly useful for holding advertising or promotional

Applicant : J. Robin Tuttle  
 Serial No. : 10/656,485  
 Page : 7

material, including pamphlets, and mounting the holder to the exterior facing side of the window pane in a manner to provide easy access to the advertising material. As described in the specification, the holder can be mounted in a window of a vehicle and held in place by simply draping the extension of the holder over the top edge of the window and the rolling the window up to at least a partially closed position. Once in place, the pamphlets or other informational material, which is stored in a pocket of the holder, is easily accessible from the exterior of the vehicle.

In one embodiment, the extension includes a looped portion with a cylindrical member positioned in the looped portion to further secure the holder in the window, as illustrated in FIG. 2 of the application, which is reproduced below.

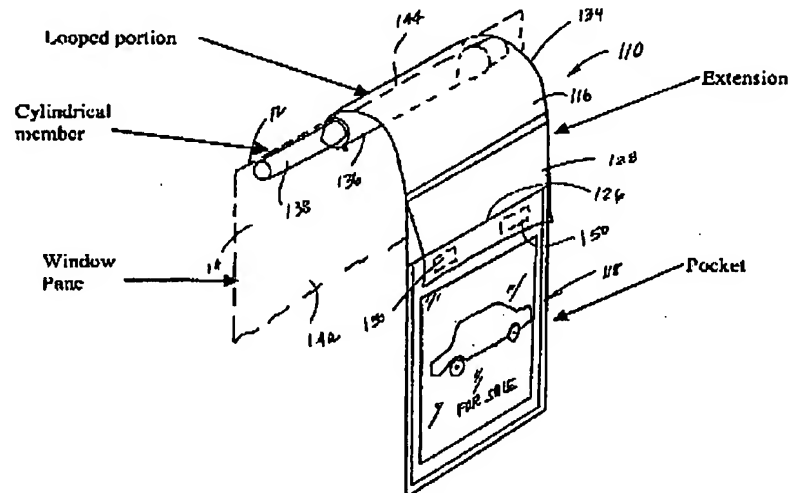


FIG. 2

Notwithstanding, Claims 9, 20, 22 and 23 are cancelled herein and Claims 1 and 16 have been amended to more clearly define Applicant's invention, which now call for:

Applicant : J. Robin Tuttle  
 Serial No. : 10/656,485  
 Page : 8

1. A holder in combination with a vehicular window pane, said holder comprising:

a vehicular window pane having an upper edge, an inner facing side for facing inwardly of a vehicle, and an exterior facing side for facing outwardly from the vehicle when the window pane is mounted in the vehicle;

a pocket for holding informational material and positioned at said exterior facing side of said window pane, said pocket having an upper edge, a side edge, three sealed sides, and an opening at or near said upper edge or at or near said side edge for inserting material into the pocket through the opening;

an extension extending from said pocket, said extension being flexible for draping over said upper edge of said window pane for hanging said pocket from said window pane, said extension including a looped portion; and

a cylindrical member in said looped portion, said cylindrical member providing a stop when said extension and looped portion are draped over said upper edge of said window pane and said window pane is in at least a generally closed position wherein said holder is engaged by said window pane and said pocket is accessible at said exterior side of said window pane.

16. A holder in combination with a vehicular window pane, said holder comprising:

a vehicular window pane having an upper edge, an interior facing side for facing inwardly of a vehicle when the window pane is mounted in a vehicle, and an exterior facing side for facing outwardly from a vehicle;

a first sheet of flexible material;

a second sheet of material secured to said first sheet and forming a pocket with said first sheet; said pocket positioned at said exterior facing side, said first sheet extending beyond said second sheet to form an extension, said extension having a length sufficient for draping over said upper edge of said window pane, and said pocket having three sealed sides and one opening for inserting material into the pocket through the opening;

a loop formed in said extension; and

a cylindrical member positioned in said loop and forming a stop when said extension and loop are draped over said upper edge to thereby support said holder from the window pane at said exterior facing surface when said extension and said loop are draped over an upper edge of a window pane and the window pane is at least partially closed.

Applicant : J. Robin Tuttle  
Serial No. : 10/656,485  
Page : 9

Applicant respectfully urges that neither Mitchell, Wosje, Dolenc, nor Johnson discloses or suggests the claimed combinations.

For example, with respect to Claim 1, Mitchell does not disclose or suggest a holder that mounts to an exteriorly facing side of a window pane and that includes an extension extending from a pocket, with the extension being flexible for draping over the upper edge of the window pane, with the extension including a looped portion with a cylindrical member therein for engagement by the window pane when the extension is placed over the upper edge of the window pane and the window pane is in at least a generally closed position.

To establish anticipation of a claim, each of the limitations must be found in a single prior art reference. Furthermore, "A claim is anticipated if only each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Moreover, "the identical invention must be shown in as complete detail as is contained in the claim". *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Furthermore, all words in a claim must be considered in judging patentability of a claim against the prior art. *In re Fine*, 873 F.2 1076, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494 (CCPA 1970).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the

Applicant : J. Robin Tuttle  
 Serial No. : 10/656,485  
 Page : 10

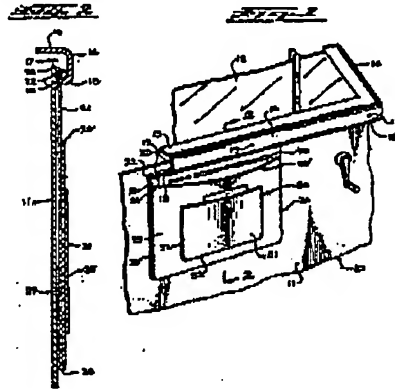
reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference or references when combined must teach or suggest all the claimed limitations. The teaching or suggestion to make the claim combination and reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See MPEP § 2143.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Where the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959). Further, all words in a claim must be considered in judging patentability of a claim against prior art. *In re Fine*, 873 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494 (CCPA 1970).

With reference to Mitchell, as illustrated in FIGS. 1 and 2 (reproduced below) and described in the '649 patent application, Mitchell discloses a carrying device to provide additional carrying space within the automobile that is conveniently accessible to the person driving or riding in the automobile. Therefore, Applicant respectfully urges that Mitchell does not disclose or suggest the claimed combination. In fact, Applicant respectfully notes that it would not be obvious to modify Mitchell to meet the claimed combination since such a modification would change the principal operation of the Mitchell device. For example,

Applicant : J. Robin Tuttle  
 Serial No. : 10/656,485  
 Page : 11

Mitchell is directed to providing carrying space within the automobile that is accessible to a person driving or riding in the automobile. Therefore, it would not be obvious to mount the Mitchell device on the exterior of the vehicle nor mount the Mitchell device to the upper edge of a window pane of a vehicle since this would obstruct the driver's view through the window when so mounted and, further, would not be accessible to a person riding or driving in the vehicle. Therefore, Applicant respectfully urges it would not be obvious to modify Mitchell to meet the claimed combination.



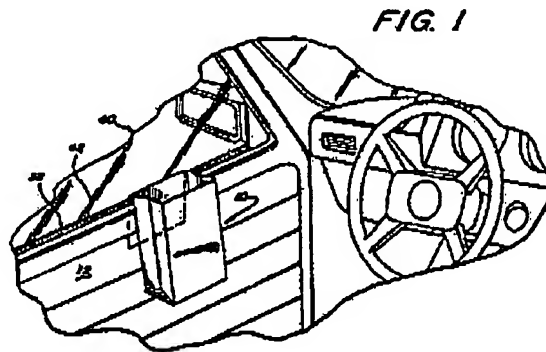
With respect to Wosje, Wosje is directed to an envelope for holding a sheaf of papers (11). Further, the envelope includes an open bottom section, as seen in FIG. 2, to provide access to the papers that are secured therein by clips 12, which are located at the upper end of the envelope. Therefore, Applicant respectfully urges that Wosje does not disclose or suggest the claimed combination. Nor would it be obvious to modify Wosje since any such proposed modification would change the principal operation of the Wosje device which is to allow a person to reach in through the bottom of the envelope and tear off a paper



Applicant : J. Robin Tuttle  
 Serial No. : 10/656,485  
 Page : 13

upper edge of the window pane, with the extension including a looped portion with a cylindrical member therein for engagement by the window pane when the extension is placed over the upper edge of the window pane and the window pane is in at least a generally closed position.

Similar to Mitchell, Dolenc is directed to a holder for inside the vehicle, as best seen in FIG. 1 of the Dolenc patent, which is reproduced below:



Therefore, even when combined, Mitchell and Dolenc do not teach the claimed combination. With respect to Wosje, Applicant respectfully urges it would not be obvious to modify Wosje in view of Dolenc to meet the claimed combination because any such proposed modification would change the principal operation of the Wosje device which is to enclose and protect a sheaf of papers and further secure the sheaf of papers to the holder, while providing access to the individual sheets of papers.

In order to achieve these goals the opening of the pocket must necessarily be located at the bottom of the envelope; otherwise, the whole sheaf would have to be removed



Applicant : J. Robin Tuttle  
 Serial No. : 10/656,485  
 Page : 14

to tear off one of the sheets. Therefore, Applicant respectfully urges that it would not be obvious to modify Wosje in view of Dolce to meet the claimed combination.

With respect to Johnson, Applicant respectfully urges that Johnson does not cure the deficiencies of Wosje either. Johnson is also directed to a holder for the inside of a vehicle and incorporates a spring wire frame that engages the upper edge of a door so that the frame lies along the inside of the door.

Applicant respectfully urges it would not be obvious to modify Wosje in view of Johnson for the same reasons noted above.

Therefore, Applicant respectfully urges that Claim 1 and its dependent claims, namely Claims 2-4, 6-8, 10-15, and 21, are patentably distinguishable over Mitchell, Wosje, Dolenc, or Johnson, or any other reference of record.

With respect to Claim 16, Applicant respectfully urges that neither Mitchell, Wosje, Dolenc, nor Johnson discloses or suggests the claimed combination at least for the reasons set forth above in reference to Claim 1. Therefore, Applicant respectfully urges that Claim 16 and its dependent claims, namely Claims 17-20, are patentably distinguishable over Mitchell, Wosje, Dolenc, or Johnson, or any other reference of record.

Accordingly, in light of the above amendments, Applicant respectfully requests reconsideration of the present application and a Notice of Allowance of all claims, namely Claims 1-4, 6-8, 10-19, 21, and 24.

Should the Examiner have any questions or suggestions, he is invited to contact the undersigned at (616) 975-5506 or at [collins@vglb.com](mailto:collins@vglb.com).


Respectfully submitted,

By: Van Dyke, Gardner, Linn & Burkhardt, LLP

Applicant : J. Robin Tuttle  
Serial No. : 10/656,485  
Page : 15

J. ROBIN TUTTLE

December 23, 2004  
Date

  
Catherine S. Collins  
Registration No. 37 599  
2851 Charlevoix Drive, S.E., Suite 207  
P.O. Box 888695  
Grand Rapids, MI 49588-8695  
(616) 975-5500

CSC:lmse